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REMARKS

Claims 14-22 are pending in the instant action. Claims 14 and 18-22 have been amended. None of the claims have been canceled. Claims 14-22 will be pending after entry of this amendment.

Attached to this response is a Statement of Sameness reiterating that the paper copy filed August 16, 2004 is identical to the CRF filed July 30, 2002.

Claims 14 and 18 were objected to for having an improper structure. Applicants have amended the claims to recite an "and" between the penultimate and last step, as per suggestion from the Examiner. Reconsideration and withdrawal of the objections are accordingly requested based upon the amendments.

Claims 18-22 were rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Applicants have amended the claims to overcome these rejections. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested based on the amendments.

Claims 14-15 and 17 were rejected under 35 USC 102/103 as anticipated by or, in the alternative, under 35 USC 103(a) over Poulouse (USPN 5,352,594) in view of Short (USPN 6,171,820). Claims 16, 18 and 21-22 were rejected under 35 USC 103(a) as being unpatentable over Poulouse (USPN 5,352,594) in view of Abo et al (WO 00/34450) and optionally in view of Short (USPN 6,171,820). The rejections are traversed based upon the Remarks set forth herein.

To anticipate a claim, a single reference must teach every element of the claimed invention (*see* MPEP 2131 et seq). As set forth in independent claim 14, the current invention is drawn to a method of obtaining a variant enzyme from a parent enzyme and includes the step of using a template and feedback to obtain the variant. Poulouse et al. do not teach the step of producing feedback (*see*, e.g., the current Office Action: the Examiner admits that the step is not recited in the reference and sets forth the tenuous claim that the step is contained inherently). Even admitting, *arguendo*, that the step were contained inherently, Poulouse et al. do not teach or suggest using a template and feedback to obtain a variant. Poulouse et al. do not teach all of the claimed limitations. Accordingly, reconsideration and withdrawal of the rejections are accordingly requested.

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Short et al. do not provide the elements to overcome this deficiency. Accordingly, reconsideration and withdrawal of the rejections under 35 USC 103 over Poulouse (USPN 5,352,594) in view of Short (USPN 6,171,820) are respectfully requested.[1]

Likewise, a *prima facie* case of obviousness requires all claimed elements (*see* 2143.03 et seq). With respect to claim 16, neither Poulouse et al, Short nor Abo et al., alone or in combination, teach or suggest producing feedback. Further, none of the rerefencs, alone or together, teach or suggest using a template and feedback in combination with iteration to produce the claimed variants. Accordingly, reconsideration of the rejection with respect to claim 16 are respectfully requested.

Likewise, with respect to independent claim 18, none of the references teach or suggest using feedback, especially in combination with interation, to produce the variant. Accordingly, reconsideration and withdrawal of the rejections with respect to claims 18 and 21-22 are respectfully requested.

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance and issuance of a formal Notice of Allowance is respectfully requested. Examiner Kerr invited to contact Applicants at (650) 846-7544 if there are additional questions or concerns.

Respectfully submitted,
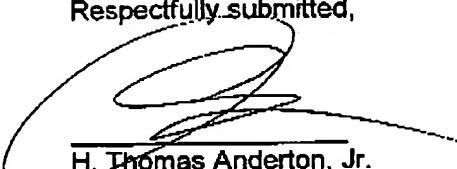
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[1] The Examiner has the burden to show a *prima facie* case; the Examiner also bears the burden of specifically proving inherency (*see*, 2112 et seq). In our case, the Examiner has neither made out a *prima facie* case nor shown inherency.